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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/823,219

04/13/2004

Robert C. Richardson

3287

9067

26645

7590

08/06/2009

THE LUBRIZOL CORPORATION  
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EXAMINER

ALEXANDER, LYLE

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

08/06/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/823,219	<b>Applicant(s)</b> RICHARDSON ET AL.	
	<b>Examiner</b> Lyle A. Alexander	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 21 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Pickup (USP 3,580,704) or Mliner et al. (USP 4,654,979).

Pickup et al. (USP 3,580,704) teach a colorimetric test for determining the pH of motor oil. Column 3 lines 28 through column 4 line 8 teaches impregnating Kraft paper with bromophenol blue, Alizarin Red, bromocresol green or bromocresol purple which has been read on the claimed "test medium" and "indicator."

Mliner et al. teach article for testing the pH of organic liquids such as a motor oil (see column 2 lines 48+). The article comprises a support material having at least one test area that contains an indicator capable of changing color. Column 3 lines 45-50 teach the support material could be an open celled foam material. Examples 1-3 in columns 5-6 teach the indicator is m-cresol purple which is indistinguishable from the claimed indicator.

Claims 1-14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Becket (USP 5,710,372).

Becket teaches in the abstract a method for measuring constituents in a lubricating fluid by a colorimetric reaction with a reagent and subsequent comparison to a color calibration scale. Column 8 lines 21+ teach the matrix or test medium can be

polymeric fibers which are indistinguishable from the claimed test medium. Column 14 lines 4-31 teach "machining fluids ... lubricant ... extreme pressure agents" which have been read on the claimed "engine oil, greases, gear oils, farm tractor fluids."

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Becket in view of either Pickup et al. or Mliner et al.

See Becket, Pickup et al. and Mliner et al. supra.

Becket is silent to the claimed indicator.

Pickup et al. and Mliner et al. teach similar colorimetric device that quantify characteristics of an oil. Pickup et al. teach bromophenol blue and Mliner et al. teach m-cresol purple.

MPEP 2144(II)(B) describes a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). A result effective variable is one that has well known and expected results. The selection of a particular indicator, to perform the indicators well known and expected function such as colorimetric determination of an oil's properties, is a result effective variable. It would have been within the skill of the art to modify Becket in view of either Pickup et al. or Mliner et al. and use either bromophenol blue or m-cresol purple as an indicator to achieve their well

known and expected functions of colorimetric detection as optimization of a result effective variable.

***Response to Arguments***

Applicant's arguments filed 4/20/09 have been fully considered but they are not persuasive.

Applicant's amendments have obviated the 35 USC 112 second paragraph rejections.

Applicant's state deleting limitations to "lubrication oils" defines over the Becket. The Office maintains the claimed "engine oil, greases, gear oils, farm tractor fluids" are sufficiently broad terms and have been properly read on the taught "machining fluids ... lubricant ... extreme pressure agents" taught by Becket.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Tuesday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lyle A Alexander  
Primary Examiner  
Art Unit 1797

/Lyle A Alexander/  
Primary Examiner, Art Unit 1797

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